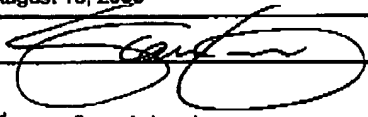
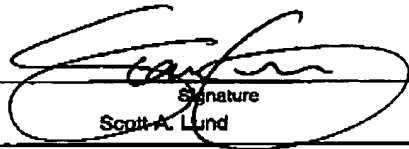


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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 10003973-1	
I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax. No. (571) 273-8300 on <u>August 18, 2006</u> Signature  Typed or printed name <u>Scott A. Lund</u>		Application Number <u>09/734,290</u>	Filed <u>December 11, 2000</u>
		First Named Inventor <u>George Bradley Hobbs</u>	
		Art Unit <u>3622</u>	Examiner <u>Jean D. Janvier</u>
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/98) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>41,166</u>		 Signature <u>Scott A. Lund</u> Typed or printed name <u>(612) 573-2006</u> Telephone number <u>August 18, 2006</u> Date	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	George Bradley Hobbs	Examiner:	Jean D. Janvier
Serial No.:	09/734,290	Group Art Unit:	3622
Filed:	December 11, 2000	Docket No.:	10003973-1
Title:	PRINT PROCESSING SYSTEM AND METHOD WITH INTERFACE ADVERTISING		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam:

Please consider the following remarks during the Pre-Appeal Brief Conference. As these remarks outline a clear legal or factual deficiency in the rejections, Applicant submits that the Pre-Appeal Brief Request for Review is appropriate.

Claim Rejections under 35 U.S.C. § 103

Claims 1-26 and 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta US Patent No. 6,891,635. Applicant respectfully traverses this rejection.

Independent claim 1 includes "communicating an interface of the customer with the print processing system controller via the network communication link" and "presenting the advertisement to the customer via the network communication link when the print processing system controller processes the job ticket for the print job" wherein presenting the advertisement to the customer includes "displaying the advertisement on the interface of the customer."

Independent claim 11 includes "communicating an interface of the customer with the print processing system controller via the network communication link and transmitting a job ticket for the print job to the print processing system controller via the interface" and "presenting the at least one of the advertisements to the customer via the network communication link" wherein presenting the at least one of the advertisements to the customer includes "displaying the at least one of the advertisements on the interface of the customer."

Independent claim 21 includes "a customer interface configured to communicate with the print processing system controller to transmit a job ticket for the print job to

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the print processing system controller" wherein the print processing system controller is adapted to "process the job ticket for the print job and display the advertisement on the customer interface when processing the job ticket."

Independent claims 1, 11, and 21, therefore, each include displaying the advertisement on the customer interface.

The Examiner recognizes that the system of the Dutta patent relates to providing advertisements in web-based printing and, more particularly, relates to providing free or subsidized printing in exchange for advertising space on printed documents (see Office Action mailed May 18, 2006, page 4, para. 2). In addition, the Examiner recognizes that the system of the Dutta patent discloses a system where advertisements can be placed on printouts requested by users of remote printers wherein advertisers sign up to advertise to the general public or to particular groups of users such that when a user is traveling and needs to print a document on a remote printer (i.e., a hotel, airport, copy service printer, etc.), the user is asked for information about their occupation and other personal attributes whereby this information is used to select advertising that is appropriate to the user such that when the user requests to print out electronic documents, the selected advertisements are included in the printout (see Office Action mailed May 18, 2006, page 4, para. 3).

The Examiner also recognizes, however, that the Dutta patent does not disclose displaying the advertisement on the customer's interface (computer screen or display), while receiving or processing the print job, instead of printing the advertisement together with the customer's document (see Office Action mailed May 18, 2006, page 7, para. 2).

As such, the Examiner takes 'Official Notice' that "it is common practice in the art to display an advertisement on a user's computer screen while the user's computer is dialing into an ISP system in order to connect to the Internet or during an idle time period as the user is waiting for a requested information or page to be retrieved or down loaded from a web server related to a web site in return for the privilege to receive free or discounted Internet service from the ISP (Internet service Provider)," that "it is well known in the art to display advertisements to a user's computer screen while the user is waiting for requested information to be retrieved or downloaded from a server related to an accessed web site," and that "[i]t is also customary in the art to allow a user accessing the Internet via an ISP to first read product

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information or advertising literature before the user is able to access the web for a limited free period of time" (Office Action mailed May 18, 2006, page 8, para. 1).

Thus, the Examiner suggests that "an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the above disclosure ('Official Notice') into the advertising distribution and printing system of Dutta so as to display a (targeted) advertisement on the screen of a computer's user upon receiving or while processing the user's print job instead of printing the advertisement along with the user's document associated with the print job..." (Office Action mailed May 18, 2006, page 8, para. 2). The Examiner contends that the motivation for doing so includes "efficiently using processing idle time by outputting the advertisement on the user's computer screen, while saving papers, ink and reducing processing time and, hence saving money, by not having to print the advertisement along with the document and while protecting the environment by using less papers and thus, cutting fewer trees, by displaying the advertisement on the user's computer screen (customer's interface)" (Office Action mailed May 18, 2006, page 9, para. 1).

Applicant submits, however, that the Dutta patent actually teaches away from displaying advertisements. For example, the Dutta patent recognizes that a challenge with Internet based advertisements or electronic forms of advertisement, such as banners on Internet web pages, is that "they only appear for a brief time to the user" and that "[o]ften when the user changes screens or visits another web page, they forget the information" such that "[i]f the user did not write the information down or store the advertiser information as a bookmark, they may not be able to remember how to contact the provider of the advertised goods or services" (col. 2, lines 60-67). Thus, by providing a system and method for providing free or subsidized printing in exchange for advertising space on printed documents, the Dutta patent seeks to provide an alternative to display-based advertising. Modifying the Dutta patent in the manner suggested by the Examiner to display the advertisement instead of print the advertisement, therefore, would simply return the system and method of the Dutta patent to the arrangement of the stated problem and result in the actual situation that the Dutta patent is trying to overcome. Applicant, therefore, submits that there is no suggestion or motivation to make the proposed modification.

In addition, Applicant submits that modifying the Dutta patent in the manner suggested by the Examiner, to display the advertisement instead of print the advertisement,

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would render the Dutta patent unsatisfactory for its intended purpose. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

For example, the Dutta patent relates to a system and method for providing advertisements in web-based printing and, more particularly, relates to a system and method for providing free or subsidized printing in exchange for advertising space on printed documents (see, e.g., Abstract; col. 1, lines 9-13; col. 2, lines 7-17; col. 5, lines 52-55; col. 6, lines 7-9). As such, the Dutta patent provides "a way to merge advertisers' objectives of identifying and targeting groups of users with users' need for printing documents" (emphasis added) (col. 2, lines 1-3).

Simply displaying the selected advertisement on an interface of the user, however, negates the advertiser's incentive for providing free or subsidized printing. For example, as outlined in the Dutta patent, displayed advertisements "only appear for a brief time to the user" such that "[o]ften when the user changes screens or visits another web page, they forget the information" (col. 1, lines 60-63). Thus, by providing free or subsidized printing in exchange for advertising space on printed documents, advertisers know the user at least has a printout containing the selected advertisement and, therefore, the advertiser information. Simply displaying the advertisement instead of printing the advertisement, however, is contrary to the advertisers' objectives of effective advertising and, therefore, contrary to the intended purpose of the Dutta patent. Applicant, therefore, submits that there is no suggestion or motivation to make the proposed modification.

In view of the above, Applicant submits that the Examiner has not established a *prima facie* case of obviousness of independent claims 1, 11, and 21, and that independent claims 1, 11, and 21 are each patentably distinct from the Dutta patent. Furthermore, as dependent claims 2-10 further define patentably distinct claim 1, dependent claims 12-20 further define patentably distinct claim 11, and dependent claims 22-26 and 29-34 further define patentably distinct claim 21, Applicant submits that these dependent claims are also patentably distinct from the Dutta patent. Applicant, therefore, respectfully requests that the rejection of claims 1-26 and 29-34 under 35 U.S.C. 103(a) be reconsidered and withdrawn, and that claims 1-26 and 29-34 be allowed.

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CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-26 and 29-34 are all in a condition for allowance and requests reconsideration of the application and allowance of all pending claims.

Any inquiry regarding this Request should be directed to either Jeff D. Limon at Telephone No. (541) 715-5979, Facsimile No. (541) 715-8581 or Scott A. Lund at Telephone No. (612) 573-2006, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

Hewlett-Packard Company
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400


Respectfully submitted,

George Bradley Hobbs,

By,

DICKE, BILLIG & CZAJA, PLLC
Fifth Street Towers, Suite 2250
100 South Fifth Street
Minneapolis, MN 55402
Telephone: (612) 573-2006
Facsimile: (612) 573-2005

Date: August 18, 2006
SAL:bms



Scott A. Lund
Reg. No. 41,166

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this paper or papers, as described herein, are being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (571) 273-8300 on this 18th day of August, 2006.

By 
Name: Scott A. Lund